

**Amendments to the Drawings**

The attached sheets 1 and 5 of the formal drawings includes changes to Figures 1 and 7. Sheet 1 replaces the original sheet 1; Sheet 5 replaces the original sheet 5. Figures 1 and 7 are amended to change the numbering of the box from 130 to 131 to avoid duplicate numbering.

Attachment: Replacement Sheets 1 and 5.

Annotated Sheets 1 and 5 showing changes.

### Remarks

Applicants respectfully request reconsideration of the above-identified application. Claims 1-24 remain in this application.

#### I. Formal Drawings

Please substitute the enclosed formal drawings Sheets 1-7 (Figures 1-11) for the informal drawings used in filing the Application.

#### II. Indefiniteness Rejection

Claims 5 and 16 were rejected under 35 U.S.C. section 112, 2<sup>nd</sup> paragraph as indefinite for reciting “at least about.” Applicants respectfully traverse this rejection. The use of the broadening modifier “about” does not automatically render a claim indefinite when used with a range. *See* MPEP 2173.05(b)&A (citing cases upholding the use of “about” with a claimed range). The use of terms of degree such as “about” is widespread in patent claims. *See Andrew Corp. v. Gabriel Electronics*, 6 USPQ2d 2020, 2012 (Fed. Cir. 1988). In fact, the recitation “at least about” has been used in the claim language of over 60,000 U.S. patents issued since 1976, according to an electronic database search conducted by Applicants’ attorney on October 3, 2005. Accordingly, it is respectfully submitted that the use of the broadening modifier “about” in this case does not render the claims indefinite.

#### III. Obviousness Rejections Based on Fuss

Claims 1-23 were rejected under 35 U.S.C. §103(a) as obvious in view of U.S. Patent 6,560,948 to Fuss combined with U.S. Patent 4,461,455 to Mills. Applicants respectfully traverse this rejection.

Fuss discloses a machine for packaging loose fill packaging material (i.e. styrofoam “peanuts”). The hopper 15 is mounted *above* the cushion supply machine. (Column 2, line 26; Figures 1 and 8a-8c.) The elevation of the cushion outlet from the cushion-supply machine is fixed *lower* than the elevation of the hopper entrance opening. (Figures 8a-8c.)

Mills discloses a machine for lifting an aircraft engine.

The prior art fails to suggest the desirability of combining Mills with Fuss. Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness has not been established to shift the burden of rebuttal to the Applicants. The mere fact that Mills *could* be combined with Fuss does not render the resultant combination obvious; the prior art must provide the teaching or suggestion supporting the combination. MPEP 2143.01.

Nothing in Mills or Fuss teaches or suggests combining the Mills aircraft engine lift with the Fuss styrofoam peanut packaging machine. The present application cannot be used as a source of motivation for combining the prior art references to attempt to arrive at the present invention. Such hindsight is impermissible and must be avoided. MPEP 2142.

The Office Action states that the motivation for combining the references is so that the Fuss packaging machine can “handle a heavier fill product if desired.” (Office Action mailed May 4, 2005 at page 3, section 4.) However, the Office Action fails to explain just how it is possible for the Mills aircraft engine lift to enable the Fuss machine to package heavier fill products. Accordingly, Applicants respectfully traverse this motivation as a basis for combining the references.

Another requirement of a *prima facie* case of obviousness is that the combination of prior art references must teach or suggest *all* of the claim limitations. MPEP §706.02(j). A claimed invention is not obvious in view of a combination of references that does not teach or suggest all of the claim recitations. MPEP §2143.03.

Even if the Mills lift were combined with Fuss to move the Fuss cushion-supply machine, the elevation of the cushion outlet from the Fuss cushion-supply machine would remain *below* the elevation of the hopper entrance opening regardless of the operation of the lift. This is because the Fuss hopper is mounted *overhead* of the cushion-supply machine. (Fuss, column 2, line 26; Figures 1 and 8a-8c.) Accordingly, the proposed combination fails to teach “a supply position in which the elevation of the cushion outlet is *higher* than the elevation of the hopper entrance opening” as recited in claim 1 (emphasis added).

The dependent claims 2-23 contain recitations in addition to those of claim 1 from which they depend, and are therefore further patentable over the combination of Fuss and Mills.

To the extent that the Office Action has taken Official Notice that hydraulic cylinders and/or hoists are well known substitutes for jackscrews in the service of elevating a cushion-supply machine, Applicants respectfully traverse the Official Notice.

#### IV. Obviousness Rejection Based on Brown

Claims 1-8 and 16-24 were rejected under 35 U.S.C. § 103(a) as obvious in view of U.S. Patent 6,672,033 to Brown.

Applicants respectfully traverse this rejection by traversing the Official Notice that it would have been obvious to move cushion-supply machine 16 “between a loading and reloading position . . . in order to lessen the stress on air conveyor 58, 151.” Applicants do not believe that this statement is capable of “instant and unquestionable demonstration as to defy dispute.” See MPEP 2144.03(A).

Claims 1-24 were rejected as obvious in view of Brown combined with Mills.

The prior art fails to suggest the desirability of combining Mills with Brown. Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness has not been established to shift the burden of rebuttal to the Applicants. The mere fact that Mills *could* be combined with Brown does not render the resultant combination obvious; the prior art must provide the teaching or suggestion supporting the combination. MPEP 2143.01.

Nothing in Mills or Brown teaches or suggests combining the Mills aircraft engine lift with the Brown air-filled packaging cushion delivery system. The present application cannot be used as a source of motivation for combining the prior art references to attempt to arrive at the present invention. Such hindsight is impermissible and must be avoided. MPEP 2142.

The Office Action states that the motivation for combining the references is “to move the supply machine to different positions instead of transporting the packages vertically by air conveyor.” (Office Action mailed May 4, 2005 at page 4, section 6.) However, because there is no cited authority supporting the proposed reason for modifying Brown with Mills, Applicants respectfully submit that a *prima facie* case of obviousness has not been established. “The factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot

be dispensed with. The need for specificity pervades this authority.” *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (cites omitted).

The factual question of motivation to combine cannot be resolved on “subjective belief and unknown authority.” *Id.* at 1434. The best defense against improper hindsight-based obviousness is the requirement for a showing of the teaching or motivation to combine prior art references. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

The dependent claims 2-24 contain recitations in addition to those of claim 1 from which they depend, and are therefore further patentable over Brown alone or the combination of Brown and Mills.

With respect to this obviousness rejection, the Office Action again states an Official Notice on page 4. To the extent that the Office Action has taken Official Notice that hydraulic cylinders and/or hoists are well known substitutes for jackscrews in the service of elevating a cushion-supply machine, Applicants respectfully traverse the Official Notice.

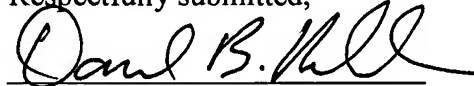
V. Conclusion

In view of these remarks, the formal drawings, and the amendments to the specification and the drawings, it is respectfully submitted that the present application is in condition for allowance. A notice to that effect is earnestly and respectfully requested.

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864/433-2496

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# Annotated Sheet Showing Changes



17

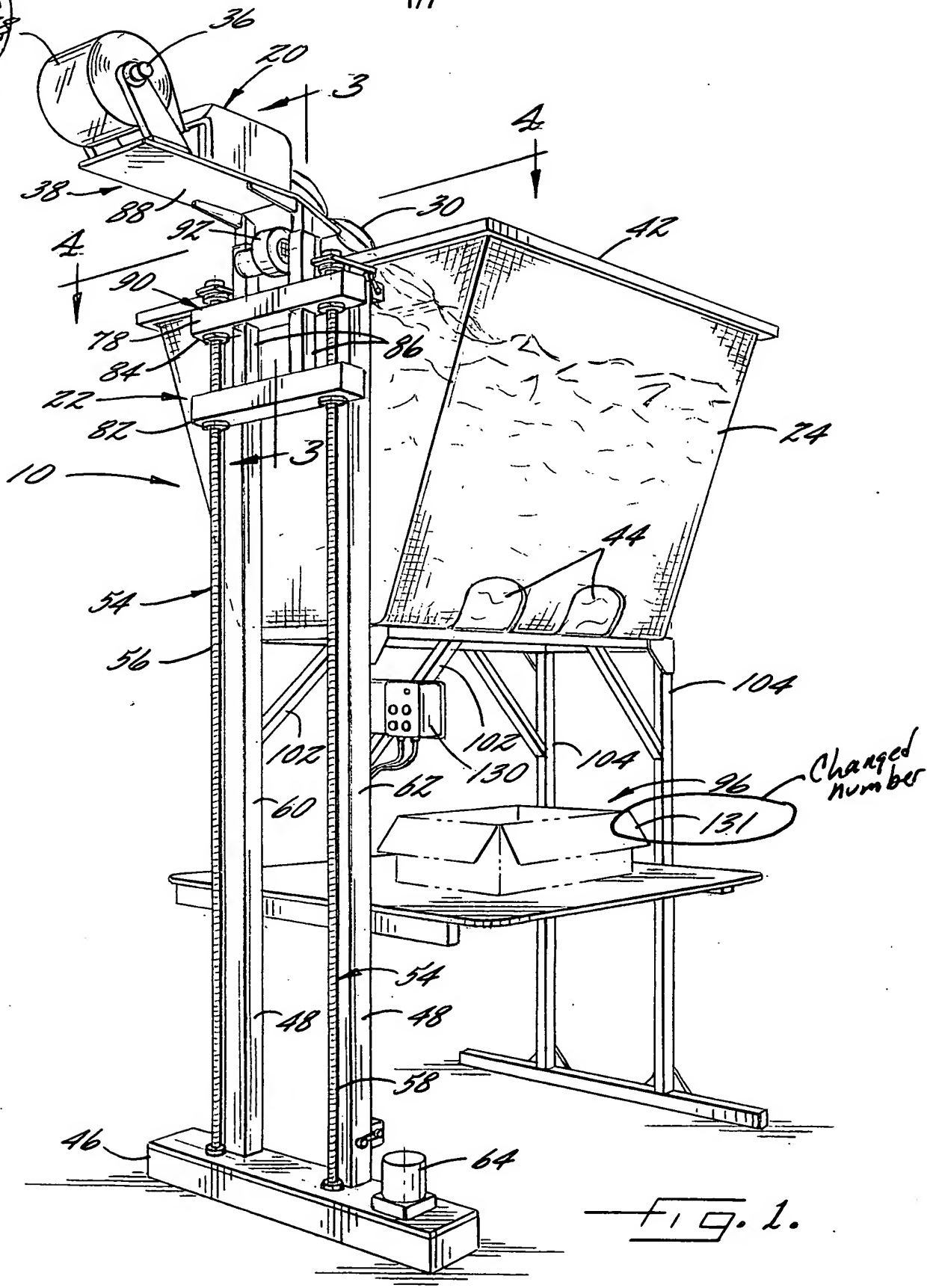


FIG. 1.



# Annotated Sheet Showing Changes

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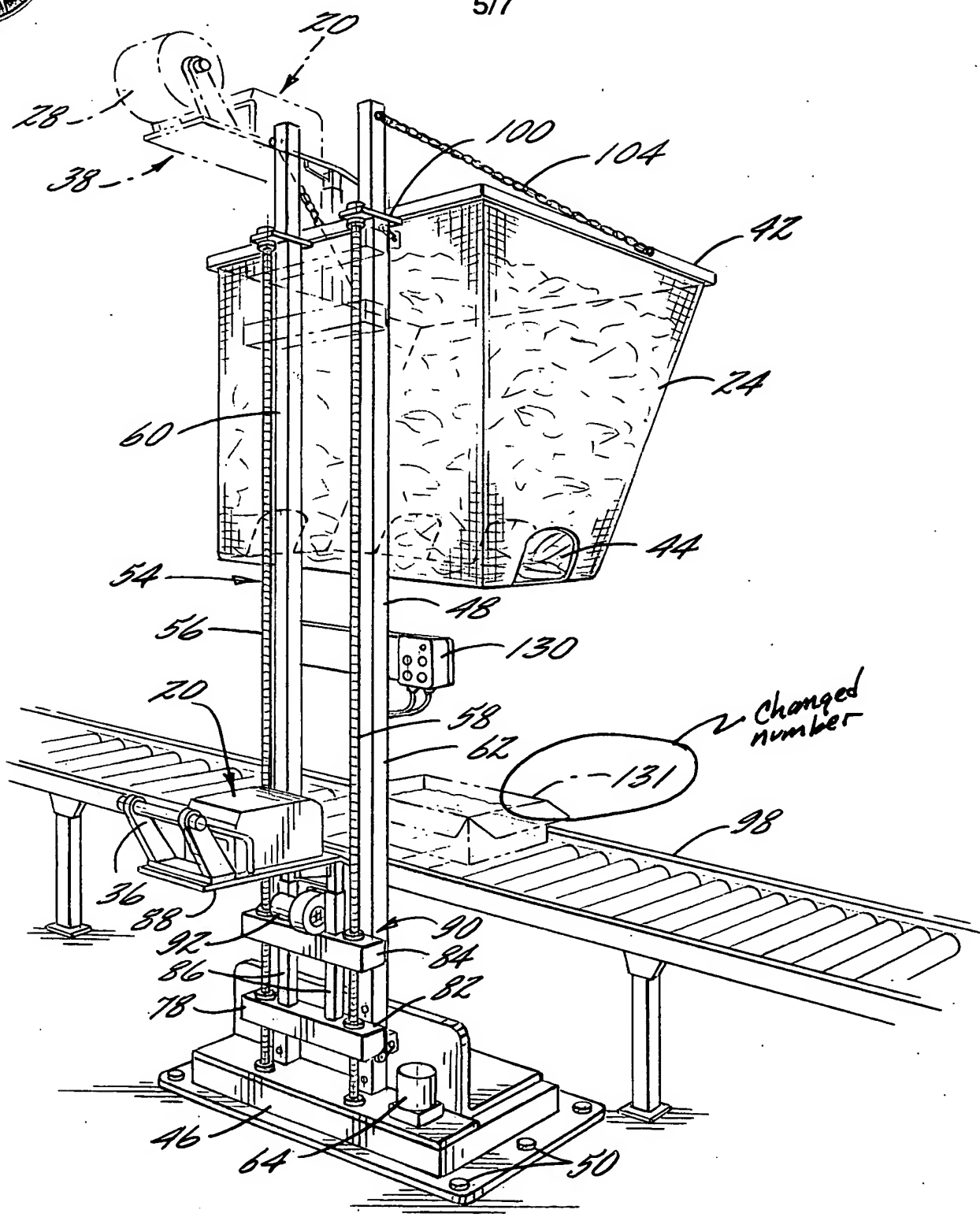


FIG. 7.